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In re Application of
SEIKI, Motoharu
Serial No.: 09/806,232
PCT No.: PCT/JP99/05349
Int. Filing Date: 29 September 1999
Priority Date: 29 September 1998
Atty. Docket No.: 1241.18
For: DNA ENCODING NOVEL
POLYPEPTIDES

DECISION

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371.

BACKGROUND

On 29 September 1999, applicant filed international application no. PCT/JP99/05349 which claimed a priority date of 29 September 1998. The international application listed Motoji Seiku as applicant/inventor. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 29 March 2001.

On 28 March 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application; a preliminary amendment; and a declaration and power of attorney executed by Motoharu Seiki.

On 30 May 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not in compliance with 37 CFR 1.497(a) and (b), and that a new oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-1.825.

On 18 July 2001, applicant filed a declaration and power of attorney.

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On 14 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that the declaration was not in compliance with 37 CFR 1.497(a) and (b), and that a new oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date was required. Specifically, the declaration was not in compliance with 37 CFR 1.497(a) and (b) because it did not identify the inventor as published in the international application. Furthermore, it was noted that the sequence listing was not in compliance with 37 CFR 1.821-1.825.

On 29 November 2001, applicants filed "Petition for Extension of Time, Response to Notification of Defective Response, and Submission of Corrected Computer Readable Form under 37 CFR 1.182(e)." The Sequence Listing was entered into the database on 13 February 2002.

On 04 December 2001, the Office PCT Legal Administration mailed "Decision Vacating Notification of Missing Requirements" which indicated the declaration filed 18 July 2001 was in compliance with 37 CFR 1.497(a) and (b) and vacated the Notification of Defective Response (Form PCT/DO/EO/916) and Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed 14 September 2001.

On 13 March 2002, the United States Designated/Elected Office (DO/EO/US) mailed Notification of Acceptance Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) was issued identifying the 35 U.S.C. 371(c) date as 28 March 2001. (The Notification was mailed to an incorrect correspondence address.)

On 04 March 2003, United States Designated/Elected Office (DO/EO/US) mailed "Withdrawal of Previously Sent Notice" vacating the Notification of Acceptance mailed 13 March 2002 and a Notification of Defective Response (Form PCT/DO/EO/916) indicating that applicant's response filed 28 March 2001 was not a complete response to the Notification of Missing Requirements mailed 30 May 2001. (These Notifications were mailed to an incorrect correspondence address. These notification were apparently mailed in response to an indication by the Technology Center that the application does not comply with the Sequence Rules. The Sequence Listing Comment Sheet from Technology Center 1600 has been included with this Decision.)

DISCUSSION

A review of the application file reveals that the basic national fee, a translation of the international application, and declaration were filed with the USPTO on 28 March 2001, the date which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. Therefore, the Notification of Acceptance mailed 13 March 2002 was proper since applicant completed the requirements set forth in 35 U.S.C. 371(c) on 28 March 2001. A copy of the Notification of Acceptance mailed 13 March 2002 has been included with this Decision.

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While the sequence listing and CRF furnished by applicant appeared, upon initial review by the United States Designated/Elected Office, to be in compliance with 37 CFR 1.821-1.825, it now appears that compliance with the sequence rules may be lacking as indicated on the Sequence Listing Comment Sheet. In view of the complexity of the subject matter at issue, the application is being forwarded to Technology Center 1600 for resolution of this issue.

The correspondence address has been corrected in the PALM Database to read: Fitzgerald Cella Harper & Scinto, 30 Rockefeller Plaza, New York, New York 10112.

CONCLUSION

The Notification of Defective Response (Form PCT/DO/EO/916) and the "Withdrawal of Previously Sent Notice" mailed on 04 March 2003 was mailed in error and are VACATED.

The application has an international filing date of 29 September 1998 under 35 U.S.C. 363 and a date of **28 March 2001** under 35 U.S.C. 371(c).

This application is being forwarded to Technology Center 1600 for prosecution including, if appropriate, a requirement for a corrected sequence listing.



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Enclosure: Notification of Acceptance Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495
(Form PCT/DO/EO/903) mailed 13 March 2002.
Sequence Listing Comment Sheet from Technology Center 1600.

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